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Paper No. 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Aerospace Corporation

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Serial No. 75/513,775

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Derrick Michael Reid for applicant.

Kelly A. Choe, Trademark Examining Attorney, Law Office 113 (Meryl L. Hershkowitz, Managing Attorney).

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Before Cissel, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by The Aerospace Corporation to register the designation THE AEROSPACE CORPORATION for "engineering and surveying in the general fields of electronics, physics and space vehicles; technical consultation and research in the general fields of electronics, physics and space vehicles, namely, industrial design."[1] Applicant claims, pursuant to Section

[1] Application Serial No. 75/513,775, filed July 6, 1998, alleging first use and first use in commerce on June 3, 1960.

2(f) of the Trademark Act, that its mark has acquired distinctiveness.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that the proposed mark THE AEROSPACE CORPORATION, when used in connection with applicant's services, is generic and, thus, incapable of functioning as a source-identifying mark. The Examining Attorney further contends that even if the designation THE AEROSPACE CORPORATION is found to be not generic, it is merely descriptive and the evidence of acquired distinctiveness is insufficient to support registration on the Principal Register. The Examining Attorney also refused to accept applicant's voluntary disclaimer of the terms "THE," "AEROSPACE" and "CORPORATION" apart from the mark as shown in the drawing.[2]

[2] In response to the proposed disclaimer submitted on August 31, 1999, the Examining Attorney indicated that the separate disclaimers were not acceptable. The Examining Attorney stated that "a disclaimer of the individual component words of a complete descriptive phrase is improper" and that "an entire mark may not be disclaimed." (Office action, December 10, 1999). In the next paper filed by applicant on June 8, 2000, applicant made no mention of the Examining Attorney's refusal to accept the disclaimer. In view of applicant's silence, the Examining Attorney may have believed that applicant no longer intended to separately disclaim the individual terms and, accordingly, the final refusal dated August 3, 2000 likewise was silent on the disclaimer. In its appeal brief, however, applicant again refers to the disclaimer, stating that it "has disclaimed the terms 'The', 'Aerospace' and 'Corporation' individually, but seeks to protect the complete name 'The Aerospace Corporation' when only

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney submitted briefs. An oral hearing was not requested.

The Examining Attorney maintains that the designation sought to be registered is generic. The Examining Attorney points to applicant's admission that it renders "engineering and research services in the aerospace industry." (brief, p. 2) Thus, the Examining Attorney contends that the term "aerospace" is the generic term for applicant's aerospace services, and that the mere addition of the terms "the" and "corporation," which have no source-indicating significance, fails to transform the otherwise generic matter into a registrable service mark. In support of the refusal, the Examining Attorney submitted dictionary

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used in a trademark sense." (brief, p. 7) In her brief, the Examining Attorney recounted the ex parte prosecution history, including the refusal to accept the disclaimer, and then went on to list the disclaimer matter as one of the issues on appeal. (brief, pp. 4-5) Applicant, in its reply brief, addressed the disclaimer matter, characterizing the issue as "whether the separate disclaimers of the components 'The' and 'Aerospace Corporation' functions to avoid over-reaching of the sought after registration rendering the registration proper." (reply brief, p. 2) Applicant concludes by stating that the disclaimer "limits the protection sought to standing-alone trademark-sense usage." (reply brief, p. 8)

Because applicant had an opportunity to respond to the refusal to enter the proposed disclaimer, there was no error in the examination by the Examining Attorney, including issuance of the final refusal on August 3, 2000, and we do not believe that the resurrection of this matter in the briefs raises a new issue. Both applicant and the Examining Attorney have treated the disclaimer matter as an issue on appeal and we will, therefore, address the issue in this opinion.

definitions of the term "aerospace,"[3] and excerpts of articles retrieved from the NEXIS database and the Internet showing uses of "the aerospace corporation," "aerospace corporation" and "aerospace corporations."

Applicant argues that the mark is not generic for the services rendered, that it is at most only suggestive of the services rendered, but in either case the evidence before the PTO is sufficient to show that the mark has acquired distinctiveness. Applicant goes on to assert that "[t]he term 'aerospace' in the aerospace industry is not primarily merely descriptive of applicant's services, but is only at most suggestive of applicant's engineering and research services in the aerospace industry" and that "the term 'The Aerospace Corporation' has acquired a secondary meaning as only indicating the applicant in the aerospace industry among all of the companies operating in the aerospace industry." (brief, p. 2) Applicant asserts that the term "The Aerospace Corporation" clearly indicates a trade name that also is used as a service mark to indicate source. Applicant further states that the term "aerospace" is ambiguous and "is not accurately defined and understood

[3] The dictionary evidence was attached to the Examining Attorney's appeal brief. The dictionary definitions constitute proper subject matter for judicial notice. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

though it is commonly used to suggest all aspects of the industry." (brief, p. 3) Applicant urges that "[t]here is only one U.S. government, there is only one NASA, and there is only one 'The Aerospace Corporation' as clearly understood throughout the aerospace industry." (brief, p. 4) In arguing the above, however, applicant also makes the following acknowledgement: "The examiner's opposition is rational, with substantial merit and supported by law, and further well argued under an advocacy ex parte orientation against registration. Indeed, much of the law cited by the examining attorney is on point and is credible." (brief, p. 3)

In support of its position, applicant submitted the declarations of George A. Paulikas, applicant's executive vice president, Roberta L. Ackley, applicant's assistant secretary, and the declaration (with accompanying exhibits) of John A. Vesco, an attorney in applicant's office of general counsel.

The Record

We now take a closer look at the evidence of record. The term "aerospace" is defined, in relevant part, as "the atmosphere and the space beyond considered as a whole; the industry concerned with the design and manufacture of the aircraft, missiles, spacecraft, etc., that operate in

aerospace; of or pertaining to aerospace or the aerospace industry" (*Random House Webster's college Dictionary* (1992)), and "of or relating to aerospace, to vehicles used in aerospace or the manufacture of such vehicles, or to travel in aerospace; the aerospace industry" (*Merriam-Webster's Collegiate Dictionary* (10th ed. 1997)).

Also of record are NEXIS excerpts which show, according to the Examining Attorney, generic uses of "the aerospace corporation" and "aerospace corporation(s)." The following are representative of the over fifty excerpts which are of record:

> The "largest, broadest, most admired aerospace corporation in the world..." *Daily News* (New York), December 16, 1996
>
> Various agencies and aerospace corporations quickly responded by submitting proposals for lunar rockets. *Sky & Telescope*, October 1996
>
> NASA announced it would give greater control of space shuttle operations to a private aerospace corporation. *Science*, November 17, 1995
>
> ...the company decided six to eight months ago to seek a partner among the major aerospace corporations. *Aviation Daily*, April 3, 1995
>
> NASA and the aerospace corporations have so much to offer... *The Houston Chronicle*, September 20, 1993

> ...employees are suing the aerospace corporation...
> *Los Angeles Business Journal*, February 3, 1992
>
> ...representatives of ten major aerospace corporations...
> *Defense Daily*, September 11, 1990
>
> At large aerospace corporations like Boeing and Northrup, the design of new aircraft is an enormously expensive effort...
> *Aerospace America*, June, 1985
>
> ...led the aerospace corporation's recovery...
> *Fortune*, October 1977
>
> Requests for interviews at government research institutes and aerospace corporations were refused.
> *The Buffalo News*, July 19, 1999

The record also includes no less than ten examples of entities in the aerospace industry using the term "Aerospace Corporation" in their names: Martin Marietta Aerospace Corporation; Gulfstream Aerospace Corporation, Ford Aerospace Corporation; Loral Aerospace Corporation; Kaman Aerospace Corporation; Grumman Aerospace Corporation; LTV Aerospace Corporation; Ball Aerospace Corporation; Bell Aerospace Corporation; and Kistler Aerospace Corporation.

In support of registrability, applicant submitted the declarations of two of its officers. Mr. Paulikas declares, in relevant part, that "the name 'The Aerospace

Corporation' has obtained widespread and unequivocal recognition and significance as identifying only the applicant from all other aerospace corporations by the use of the precursor term 'THE'"; and that the "trade of aerospace systems design know only one company, that is the applicant who is known as The Aerospace Corporation." (emphasis in original).

Ms. Ackley fills in the details of applicant's use:

> On information and belief, since its incorporation on October 1, 1960, The Aerospace Corporation has accumulated revenues over $8.8 billion dollars in connection with applicant's services including developmental and research services in the aerospace industry, providing its service to at least 365 large governmental, educational and corporate clients and currently has over 2000 vendors. Over the past 40 years, the term "The Aerospace Corporation" has acquired distinctiveness indicating only applicant, The Aerospace Corporation, in the aerospace industry.
>
> On information and belief, the applicant, The Aerospace Corporation, has used the mark "The Aerospace Corporation" as an indication of the source of its services, exclusively and continuously in connection with offering its services for those 40 years.
>
> On information and belief, the applicant has used the mark "The Aerospace Corporation" in the aerospace industry for 40 years without confusion

as to the source of applicant's services.

The Law

We turn first to the issues of whether the designation THE AEROSPACE CORPORATION is generic, or whether it is just merely descriptive, when used in connection with "engineering and surveying in the general fields of electronics, physics and space vehicles; technical consultation and research in the general fields of electronics, physics and space vehicles, namely, industrial design." A mark is merely descriptive if, as used in connection with the goods and/or services, it describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, feature, etc. thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the goods and/or services. See: In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Eden Foods Inc., 24 USPQ2d 1757 (TTAB 1992); and In re American Screen Process Equipment Co., 175 USPQ 561 (TTAB 1972). The issue is not determined in a vacuum, but rather the mere descriptiveness of the mark is analyzed as the mark is used in connection with the goods and/or services. A mark is a generic name if it refers to the class or category of goods and/or services on

or in connection with which it is used. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Act; In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., supra. The United States Patent and Trademark Office has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. In re Merrill Lynch, Pierce, Fenner and Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

Genericness

With respect to genericness, the type or category of services at issue is broadly identified as aerospace

services. Moving on to the second step of the Ginn inquiry, that is, whether the relevant purchasing public understands the designation THE AEROSPACE CORPORATION to refer primarily to the type or category of service, we find that it does. Purchasers would perceive the designation to name aerospace corporation services, that is, aerospace services that emanate from aerospace corporations.

There can be no dispute, and applicant concedes as much (especially given the proposed disclaimer of the individual words in the designation), that the separate words "the," "aerospace" and "corporation" lack any source-indicating significance. The definite article "the" in the proposed mark is devoid of any trademark significance.[4] See: In re G.D. Searle & Co., 360 F.2d 650, 149 USPQ 619 (CCPA 1966), aff'g, 143 USPQ 220, 222-223 (TTAB 1964)["THE PILL" is generic for oral contraceptive; "the utilization of the article 'the' and of quotation marks cannot convert a simple notation comprising ordinary words of the English

[4] Of record by way of applicant's submission is an excerpt from the October 1, 1960 minutes of a meeting of applicant's board of trustees. The minutes read as follows: "Consideration was given to the simplification of the name of the corporation by dropping the word 'The' before The Aerospace Corporation which is the name approved in the Articles of Incorporation. The Chairman expressed the view that it was not necessary to use the 'The' in anything but the most official formal documents and that he felt that any amendment to the Articles to make this change could be accomplished at some future date in connection with some other more significant amendment when and if one becomes necessary."

language used in their ordinary sense into a registrable trademark."]; and GMT Productions, L.P. v. Cablevision of New York City, Inc., 816 F.Supp. 207 (SDNY 1993)["[U]se of the word 'the' before an unprotectable mark does not convert an otherwise generic term into a descriptive one."]. The Examining Attorney provided dictionary definitions of the word "aerospace." This term by itself clearly identifies the type or category of applicant's services. Lastly, the word "corporation" standing alone hardly has any source-identifying function. See, e.g., In re Packaging Specialists, Inc., 221 USPQ 917, 919 (TTAB 1984); and *TMEP* §1213.02(d).

It is applicant's contention, however, that it is the relevant public's perception of the proposed mark *in its entirety* that must control the result here. And, indeed, our primary reviewing court recently affirmed the principle espoused by applicant, that is, that the proposed mark must be analyzed as a whole. In re Dial-A-Mattress Operating Corp., supra at 1811.

We find that the Office has met its burden in showing that the proposed mark *as a whole* is generic. The combination of two terms lacking source-identifying function, "the" and "corporation," coupled with the clearly generic term "aerospace," results in a designation that, in

its entirety, is generic. Further, the critical evidence here which distinguishes the present case from the Dial-A-Mattress case is the NEXIS evidence. Ordinary language usage of the terms "aerospace corporation," "aerospace corporations" and "the aerospace corporation" shows that the designation "the aerospace corporation" in its entirety is commonly used in connection with the aerospace industry and its services. The public refers to these services as "aerospace services," and entities that provide such services are referred to as "aerospace corporations." The NEXIS evidence also includes examples of corporations in the industry, undoubtedly competitors of applicant, that use the designation "Aerospace Corporation" in their names. Even if the designation is considered to be a phrase (rather than a compound), the evidence shows use of the designation "the aerospace corporation" and/or virtually identical designations and, thus, the term would still be generic under this analysis. See: In re American Fertility, supra.

Based on the record before us, we find that the designation THE AEROSPACE CORPORATION is generic for the aerospace services at issue.

Mere Descriptiveness

Even if we had not found THE AEROSPACE CORPORATION to be incapable of identifying and distinguishing applicant's services, we nevertheless would affirm the refusal to register on the ground of mere descriptiveness. The designation sought to be registered immediately conveys the impression that aerospace services are rendered by applicant. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Given the evidence of record (most especially, the dictionary definitions), and applicant's comments regarding its "aerospace services" in the "aerospace industry," we are entirely unpersuaded by the argument that the term "aerospace" is ambiguous and, therefore, just suggestive. To the contrary, it is clear that the term has a specific and commonly understood meaning when it is used in connection with services of the type rendered by applicant.

Acquired Distinctiveness

In finding that the designation THE AEROSPACE CORPORATION is incapable of being a source identifier for applicant's aerospace services, we have considered, of course, all of the evidence touching on the public perception of this designation, including the evidence of

acquired distinctiveness. As to acquired distinctiveness, applicant has the burden to establish a prima facie case of acquired distinctiveness. Yamaha International Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988).

As indicated above, applicant submitted the declarations of two of its officers setting forth a few specifics about applicant's use for over forty years. Applicant's total revenues exceed $8.8 billion, with services provided to at least 365 large governmental, educational and corporate clients through over 200 vendors. Applicant also asserts that it is the only entity in the industry known as "The Aerospace Corporation."

Applicant's long use and revenues suggest that applicant has enjoyed a degree of business success. Nonetheless, this evidence demonstrates only the popularity of applicant's services, not that the relevant customers of such services have come to view the designation THE AEROSPACE CORPORATION as applicant's source-identifying service mark. In re Bongrain International Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and In re Recorded Books Inc., 42 USPQ2d 1275 (TTAB 1997). The issue here is the achievement of distinctiveness, and the evidence falls far short of establishing this. Applicant's evidence is

outweighed by the NEXIS evidence showing use of "the aerospace corporation" to refer to others in the industry.

To be clear on this significant point, we emphasize that the record is completely devoid of *direct* evidence that the relevant classes of purchasers of applicant's aerospace services, such as governments, educational institutions and corporations, view THE AEROSPACE CORPORATION as a distinctive source indicator for applicant's services.

Accordingly, even if the designation THE AEROSPACE CORPORATION were found to be not generic, but merely descriptive, given the highly descriptive nature of the designation THE AEROSPACE CORPORATION, we would need to see a great deal more evidence (especially in the form of direct evidence from customers) than what applicant has submitted in order to find that the designation has become distinctive of applicant's services. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. Yamaha Int'l. Corp. v. Hoshino Gakki Co., supra; and In re Merrill Lynch, Pierce, Fenner & Smith, Inc., supra. See also: *Restatement (Third) of Unfair Competition* (1993), Section 13, comment e:

> The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness. Indeed, some designations may be incapable of acquiring distinctiveness.

Applicant's contention that it is the only one in the trade using "THE AEROSPACE CORPORATION," and that others in the industry recognize this uniqueness and that the designation identifies only applicant and its services is not persuasive. We respond by simply saying that the designation, as used in connection with aerospace services, is not unique in that it is not distinctive. See: In re E S Robbins Corp., 30 USPQ2d 1540, 1542-43 (TTAB 1992). As shown by the record, any number of entities in the aerospace industry use the term "aerospace corporation" in a generic manner. The multiple uses of the designation "the aerospace corporation" show that there is nothing coined about the designation.

In sum, the proposed mark is a common designation used in the industry to identify aerospace corporation services, that is, aerospace services rendered by an aerospace corporation in the aerospace industry. The designation THE

AEROSPACE CORPORATION is generic and does not and could not function as a service mark to distinguish applicant's services from those of other aerospace corporations' services and serve as an indication of origin. The designation sought to be registered should not be subject to exclusive appropriation, but rather should remain free for others in the industry to use in connection with their aerospace corporation services. In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999).

Disclaimer

Applicant submitted a disclaimer of the individual words "the," "aerospace" and "corporation" apart from the mark. The Examining Attorney declined to accept and enter the disclaimer, asserting that disclaimers of individual component words of a complete mark are not permitted and that, in any event, the separate disclaimer does not overcome the genericness refusal.

The disclaimer is improper. The designation THE AEROSPACE CORPORATION is a unitary expression, and a disclaimer of the individual components is not permissible. See: In re Medical Disposables Co., 25 USPQ2d 1801 (TTAB 1992); In re Wanstrath, 7 USPQ2d 1412, 1413 (Comm. Pats. 1987); American Speech-Language-Hearing Association v.

National Hearing Aid Society, 224 USPQ 798, 804 at n. 3 (TTAB 1984); and In re Surelock Mfg. Co., Inc., 125 USPQ 23, 24 (TTAB 1960). *TMEP* §1213.09(b) states the following: "This standard should be construed strictly; thus, disclaimer of individual words separately will usually be appropriate only when the words being disclaimed are separated by registrable wording." Further, in the present case, an entire mark may not be disclaimed. U.S. Steel Corp. v. Vasco Metals Corp., 394 F.2d 1009, 157 USPQ 627 (CCPA 1968); and In re Wine Society of America Inc., 12 USPQ2d 1139 (TTAB 1989). That is, if a mark is not registrable as a whole, as we have held here, a disclaimer will not make it registrable. *TMEP* §1213.07. See: Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991). In sum, the disclaimer is unavailing.

Decision: The refusal to register is affirmed.